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(2) REMARKS

Unobviousness

Claims 1-3, 5-9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Persson in view of Blaschke, *et al.* Claims 4 and 10 are rejected also under 35 U.S.C. 103(a) as being unpatentable over Persson in view of Blaschke, *et al.*, but further in view of Pappas, *et al.*

The examiner repeats the rejection as made in the previous Office Action. Applicants likewise rely upon the arguments they presented in response to that Office Action and respond only to the points made in the current Office Action.

The examiner disagrees with applicants' position that the references are not combinable. The examiner addresses this point by arguing that "[c]ookies and candy are common treats to children. Thus, what is playful and novel to one product is equally playful and novel to the other.... Thus, having the teaching of Persson and Blaschke *et al.*, it would have been obvious to one skilled in the art to incorporate the teaching of Persson in making the cookie of Blaschke *et al.* to make an appealing cookie when such product is intended for children." Applicants submit, however, that the above reasoning from the Office Action does not address the issue of how the references can be combined without changing their essential features and adding features shown or suggested by none. Importantly, the mere fact that both cookies and candy can be made to be entertaining to children, does not explain how one skilled in the art knowing the teachings of Persson would address the issue of making the claimed cookie product using the specific teachings of Persson.

Applicants respectfully traverse the conclusions made by the examiner, here, and request that the examiner again consider the supporting rationale. Applicants have previously pointed out that the product of Persson is quite different from both the product of the invention and that of the Blaschke *et al.* reference, with which the examiner proposes combining the teachings of Persson.

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There are several distinct differences between the invention and what Persson shows. Among these are the facts that: (1) the "picture" of Persson is a flat, two-dimensional printed picture, (2) the Persson process requires separate equipment for both cookie (wafer) forming and candy forming and (3) the Persson process includes six distinct manipulative steps that the present invention does not and which cannot be accomplished on conventional cookie forming equipment. Applicant has provided a simplified process, which uses a three dimensional image and a different manner of hiding it, enables equipment to be eliminated, and enables processing steps and work to be reduced – all without affecting the entertainment value that might be associated with a product of the type made by Persson.

The examiner states that "[t]he picture of Persson can resemble a television set; thus, the image can be in three dimensional form." The reference, however, actually states that: "[t]he wafer and toffee may be shaped to resemble a television set and to make it apparent which is the side to be licked in order to disclose the picture." This passage does not in any manner teach or suggest anything other than a two-dimensional picture, whatever the outer configuration of the composite wafer and toffee. The picture is flat and covered with a uniform coating. It is not three dimensional, with coating material deeper in recesses.

It will be recalled that Persson starts out with a toffee candy and then (a) forms "a recess or depression 11 in one surface only of each lollie", (b) forms a wafer of the same thickness as the depth of the recess, (c) prints a two-dimensional image on the wafer with a specially formulated ink, (d) places the wafer 15 in the recess 11, (e) covers the wafer 15 with hard candy 14 (chosen so that the picture can be seen through it, a fact that would prevent the outer coating 18 from filling recesses in a three-dimensional image were they provided), and finally (f) covering the hard candy layer with a soft coating 18 of chocolate or ice cream which can be more readily dissolved than the candy 14. Persson prints a flat picture, covers it up with a continuous coating that continues to cover the picture even after it is revealed. The configuration of applicants' claimed image is actively involved in its revelation. The image of Persson is two-dimensional and cannot play any active role.

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The examiner now contends that applicants' arguments that the Persson process is not suitable for performance by convention cookie forming equipment, is not supported by any evidence. Applicants submit, however, that the person skilled in the art will be aware that cookie equipment has baking as its key feature, and that the candy forming and assembling system of Persson cannot bake a cookie. The Persson process is all about forming a layered candy having a printed flat wafer insert embedded in a base toffee candy under two more layers of candy. Applicants believe that it is clear that this does not either teach or suggest the use of cookie equipment.

Applicants had also argued that the combination proposed by the examiner would fully change the product of Persson. In response, the examiner states that "[i]t is true that such conversion fully changes the product because cookie is different than candy." The examiner also states that "[t]he question to be answered is that would such conversion have been obvious to one skilled in the art. It is the examiner's position that such conversion would have been obvious to one skilled in the art when one wants to make a cookie product with playful feature which is intended to appeal to children." Applicants point out, however, that this position is an improper basis for denying a patent to applicants because (1) it assumes that the reference would be read by a skilled worker as teaching cookies and (2) it disregards the processing and cookie structural differences noted above. Neither the conversion of the candy and two-dimensional cookie product of Persson to the three-dimensional cookie product of the invention, nor the process and product differences noted above would in any way be taught or suggested by Persson taken alone or with any of the other prior art cited.

The examiner cites *In re McLaughlin*, 170 U.S.P.Q. 209, as support for the use of hindsight in the Office Action. However, that case is not consistent with the facts in this one. There, the case against the applicant did "not include knowledge gleaned only from the applicant's disclosure..." In the present case this is exactly what the rejection does. The combination presented in the Office Action requires, impermissibly, for the person of skill in the art having the Persson, Blaschke, *et al.* and Pappas, *et al.* references in front of him, to also

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have applicants' disclosure of the type of product, its component parts and its construction. Otherwise, the invention could not be made in the manner claimed. Absent applicants' teaching or suggestion, there would be no reason to modify any of the references or to combine any of them in any way. The Court of Appeals for the Federal Circuit has laid out the test of hindsight in numerous cases over the years, and the present set of fact falls squarely within the parameters they find as improper. In the case of *In re Anita Dembiczak, et al.*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), they state:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also *Graham*, 383 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). In this case, the Board fell into the hindsight trap.

Applicants believe that the parallels are strong with this application and the *Dembiczak* case and the others cited therein. The invention as a whole must be evaluated in light of the fair teachings and suggestions provided by the references. In the present case, there is too much left

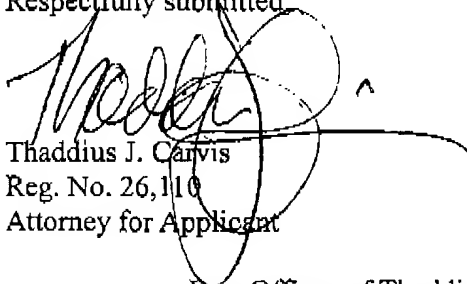
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to the imagination of the skilled worker to arrive at applicants' claimed invention, even were the person skilled in the art to find the noted references. There is no reason why the person skilled in the art would start modifying the presumptively operable and satisfactory procedures to arrive at applicants' claimed invention – unless the person skilled in the art also had applicants' invention in front of him.

Applicant has made a significant improvement in cookie products by providing one that is simple to make with conventional equipment, yet is entertaining and engaging. The claims clearly and concisely set this invention out in terms that patentably distinguish from the prior art. Accordingly, reconsideration and allowance of all claims are believed in order, and such actions are earnestly solicited. If applicant's representative can advance the application toward allowance by telephone, the examiner is requested to call him at the number listed below.

Respectfully submitted



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